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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,315	01/17/2002	Cesar-Emilio Zertuche-Rodriguez	205,289	9220
7590	10/08/2004		EXAMINER	
ABELMAN FRAYNE & SCHWAB Attorneys at Law 150 East 42nd Street New York, NY 10017			ANTHONY, JOSEPH DAVID	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/053,315	ZERTUCHE-RODRIGUEZ ET AL. <i>[Handwritten Signature]</i>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 September 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,4 and 6-17 is/are pending in the application.
- 4a) Of the above claim(s) 7-17 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-2, 4, and 6 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## FINAL REJECTION

### *Specification*

1. The amendment filed 09/22/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

A) Applicant's cancellation of "an adherent" to describe a compound and replacing "an adherent" with the phrase "that improves the adhesion of the suspension to the pellets". This amendment is deemed to expand the scope of the adherent compound. Applicant has pointed out no support in the originally filed disclosure for the said phrase. In fact, no definition of the adherent compound can be found in the originally filed specification. Applicant only gave one example of an adherent compound and that was a styrene-acrylic emulsion, see page 13, lines 3-8 of the specification.

B) Applicant's adding the units of "by weight" after the listed concentration ranges of the chloride content and calcium content of the suspension. Once again applicant ha set forth in support in the originally filed specification for such units in regards to these two specific compounds. The examiner found support for the units "by weight" for the other claimed component in example 1 of the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-2, 4, and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new matter in these claims is the same new matter that applicant added to the specification. See the above objection to the specification for details.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-2, 4 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 is indefinite for a number of reasons which are as followed:

- 1) Independent claims 1 and 4 are indefinite because there are no units given for the 30% concentration range of the "compound that improves the adhesion of the suspension to the pellets".

2) When the claimed percentages are totaled up they exceed 100%, which is impossible. As an example, independent claim 1 is limited to where the solids content of the suspension is from "about 51% to 61% by weight" and the water content is from "about 39% to 49% by weight". The magnesium hydroxide content is claimed to be almost all of said solids content of the suspension since it is listed at "about 50% to 60% by weight". How is it thus possible for the suspension to have a concentration range for the anionic polyelectrolyte dispersant agent of "at least 25% by weight, in an amount of about 0.5 to about 2.5% by weight on a dry basis" and at the same time to have a concentration range of the "compound that improves the adhesion of the suspension to the pellets" "of at least 30% in an amount of about 0.5 to 5% by weight, on a dry basis"? After all, the suspension has an overall water content of about 39% to 49% by weight, and the calculated minimum water content of anionic polyelectrolyte dispersant agent component is about 24.4% by weight (i.e.  $25\% \times 0.975 = 24.375\%$  by weight assuming maximum solid content is 2.5% by weight), and the calculated minimum water content of the compound that improves the adhesion of the suspension to the pellets is 28.5% by weight (i.e.  $30\% \times 0.95 = 28.5\%$  by weight assuming the maximum solid content is 5% by weight). The total combined minimum water content from just these two said component is 52.875% by weight which is outside of the total suspension water content of about 39% to about 49% by weight.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins et al. U.S. Patent Number 4,412,844 in view of Zertuche-Rodrigues et al. U.S. patent Number 5,811,069.

Collins et al discloses stable oil-dispersible magnesium hydroxide aqueous slurries comprising: A) 20-70% magnesium hydroxide having a particle size of 50 to 1.0 microns, preferably about 30-2 micron; see abstract and column 2, lines 41-59, B) 79-29% water, C) 1.0-8.0% of a water-in-oil emulsifying agent having an HLB value of 2 to 11, and D) 0.1-6% of a water soluble water in-oil emulsifying agent having an HLB of from 10 to 40. The viscosity of said dispersion is from 100-5000 cps. Disclosed examples of component D) are polymeric materials such as acrylic acid-acrylate copolymers, see column 3, lines 40-54.

Collins et al. differs from applicant's claimed invention in the following ways: 1) there is no direct teaching (i.e. by way of an example) to a slurry composition that contains all of applicant's claimed components that is within applicant's claimed pH range of 10.5 to 12, 2) there is no direct teaching (i.e. by

way of an example) to applicant's particularly claimed solids particle size ranges and 3) there is no direct disclosure to applicant's claimed styrene-acrylic emulsion adherent component of claim 6.

Zertuche-Rodrigues et al. discloses long-term stabilized magnesium hydroxide suspensions that are identical to applicant's claimed suspensions except that the viscosity is lower than claimed by applicant, and there is no disclosure of an adherent compound.

It would have been obvious to one having ordinary skill in the art to use the broad disclosure of Collins et al as motivation to actually make magnesium hydroxide slurry that contained all of applicant's claimed components within applicant's claimed pH range. It should be pointed out that the base magnesium hydroxide slurry used by Collins et al was commercially available under the name MHT-60 which had a pH of 10.5-10.7, see column 2, lines 13-40, which established that such pH ranges are well known in the art. Further support on the obviousness of applicant's claimed pH range is found in the secondary reference to Zertuche-Rodrigues et al. which directly teaches that stable magnesium hydroxide suspension are known to have a pH within the range of 10.5 to 12, see claim 1.

It would also have been obvious to one having ordinary skill in the art to use the disclosure of the secondary reference to Zertuche-Rodrigues et al. as motivation to make a magnesium hydroxide slurry accordingly to Collins et al that had a total particle size distribution as claimed by applicant since such a particle

size distribution is directly taught by Zertuche-Rodrigues et al. in claims 3 and 5 and is within the broad range disclosed by Collins et al..

Finally, applicant's claimed styrene-acrylic emulsion, as the adherent component of claim 6, is deemed to fall within the generic disclosure of Collins et al components C) and/or D). It is also noted that applicant's specification has no showing of any superior and/or unexpected results that may result when a styrene-acrylic emulsion is used as the adherent component in magnesium hydroxide suspensions.

***Response to Arguments and Amendment***

8. Applicant's arguments filed 02/22/04 with the amendment have been fully considered but are not persuasive to put the application in condition for allow for the reasons set forth above. Additional examiner comments are found below. Applicant must remember that the claimed invention is drawn to a suspension and not to a method of using the suspension to cover pellets, as such all of applicant's arguments against the Collin et al patent because it does not directly disclose applicant's intended use of the claimed suspension to cover pellets is deemed to be moot. Furthermore, the examiner maintains that applicant's styrene-acrylic emulsion can be properly considered as falling within Collin et al's emulsifying agents of components C) and/or D). In any case, only applicant's claim 6 limits the "compound that improves the adhesion of the suspension to the pellets" to a styrene-acrylic emulsion".

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

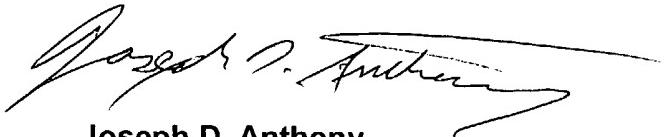
***Examiner Information***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. This examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 6:30 p.m. in the eastern time zone. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (703) 872-9306.

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All other papers received by FAX will be treated as Official communications and cannot  
be immediately handled by the Examiner.



**Joseph D. Anthony**  
**Primary Patent Examiner**  
**Art Unit 1714**



10/11/02